

REMARKS

In the Office Action, Examiner Zervigon stated that in response to Applicant's request for continued examination (RCE) under 37 CFR §1.114, "Applicant's submission filed on November 12, 2002 has been entered." From this and the remainder of the Office Action, it is evident that the Examiner did not enter any of Applicants' other submissions filed after the final rejection of July 31, 2002 (Paper No. 8), namely, an amendment filed September 30, 2002, substitute drawings filed October 1, 2002, and a reply and Rule 132 affidavit filed January 10, 2003, the latter of which was resubmitted at the Examiner's request on May 7, 2003. The November 12 submission that was entered by the Examiner was merely a statement that an Advisory Action dated October 10, 2002 (Paper No. 10) failed to comply with MPEP 706.07 and 707.07(f) because it failed to address any of Applicants' arguments raised in their amendment of September 30, 2002. Because the three unentered submissions contained Applicants' responses to the final rejection of July 31, 2002, the Examiner simply copied verbatim the claim rejections in the present Office Action from the Office Action of July 31, 2002.

To help clarify the above, the following timetable is provided.

Application No. 09/624,810
Docket No. 13DV-13228
Amendment dated November 26, 2003
Reply to Office Action of August 26, 2003

| <u>Date:</u> | <u>Description:</u> |
|--------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 07/24/2000 | Application filed by Applicants. |
| 04/05/2002 | Information Disclosure Statement filed by Applicants. |
| 02/19/2002 | Office Action (Paper No. 4) filed by Examiner. |
| 05/17/2002 | Amendment and Request for Drawing Corrections filed by Applicants. |
| 07/31/2002 | Office Action (Paper No. 8) filed by Examiner (final rejection). |
| 09/30/2002 | Amendment filed by Applicants. |
| 10/01/2002 | Substitute Drawings filed by Applicants. |
| 10/10/2002 | Advisory Action (Paper No. 10) filed by Examiner. |
| 11/08/2002 | Reply filed by Applicants (arguing the Advisory Action (Paper No. 10) was incomplete and nonresponsive). |
| 11/29/2002 | Advisory Action (Paper No. 13) filed by Examiner. |
| 01/10/2003 | Reply and Rule 132 affidavit filed by Applicants (the reply argued that the Advisory Action (Paper No. 13) was also incomplete and nonresponsive). |
| 05/07/2003 | Reply of 01/10/2002 resubmitted at request of Examiner. |
| 05/20/2003 | Notice of Abandonment filed by Examiner. |
| 06/04/2003 | Petition for Revival and RCE filed by Applicants. |
| 06/17/2003 | Petition granted by USPTO. |
| 08/26/2003 | Present Office Action (Paper No. 18) filed by Examiner, entering Applicants' submission of 11/08/2002 but not Applicants' submissions of 09/30/2002, 10/01/2002 and 01/10/2003. |

It is unclear to Applicants why only the third of four submissions filed after the final rejection of July 31, 2002 would be entered by the Examiner.

To avoid the possibility that Applicants' submissions of 09/30/2002, 10/01/2002, and 01/10/2003 will not or cannot be entered retroactively, Applicants are resubmitting copies of the submissions of 09/30/2002 and 01/10/2003 as attachments to this response. Applicants hereby specify that the arguments (but not the claim amendments) presented in these submissions are incorporated herein by reference, and therefore require consideration by the Examiner. A summary of these submissions is as follows:

(1) The submission of 09/30/2002 was a "Reply under 37 CFR §1.116" filed in response to the final claim rejections made in the Office Action of July 31, 2002. The 09/30/2002 submission included an amendment to claim 1 that overcame the same objection raised in paragraph 6 of the present Office Action. This amendment is now being re-presented with this response to the present Office Action. Because the claim rejections in the present Office Action are copied verbatim from the Office Action of July 31, 2002, the arguments in the attached copy of the Reply of 09/30/2002 also serve as Applicants' response to all of the claim rejections made in the present Office Action.

(2) The submission of 01/10/2003 included a "Reply under 37 CFR §1.116" and a "Declaration under 37 CFR §1.132" in response to the Advisory Action of November 29, 2002. The Reply presented further arguments directed to the on-sale/public-use rejection raised in the Office Action of July 31, 2002. In particular, the 01/10/2003 Reply describes the results of telephone interviews with Supervisory Patent Examiner Gregory L. Mills and SPRE Christine Tierney, who instructed that on-sale/public-use rejections are governed by the decision in *Field v. Knowles*; *Field and Stover v. Same*, 86 USPQ 373 (CCPA 1950), and not the cases cited by Examiner Zervigon to maintain the on-sale/public-use rejections in the present application. Applicants' Declaration was deemed by Examiner Mills to fulfill the requirements of *Field* with respect to Applicants' then co-pending U.S. Patent Application Serial No. 09/624,808 (now U.S. Patent No. 6,589,351), which claimed components of the very same EBPVD coater at issue in Applicants' rejected claims.

The submission of 10/01/2002 was a "Substitute Drawings" request to the attention of the Official Draftsperson. This submission included substitute sheets for Figures 10 through 12 to address the same drawing issues raised in paragraphs 2 through 5 of the present Office Action. Because the drawing correction process that existed on 10/01/2002 has been eliminated, the formal corrected Figures 10 through

12 originally submitted on 10/01/2002 are being submitted as an attachment to this response to the present Office Action.

As indicated above, the claim rejections in the present Office Action are copied verbatim from the Office Action of July 31, 2002. As such, the attached copies of the Replies and Rule 132 Affidavit constitute Applicants' response to all of the claim rejections repeated in the present Office Action. However, Applicants wish to make the following additional brief observations.

In the Advisory Action of November 29, 2002 (Paper No. 13), the Examiner indicated that Applicants' response of November 8, 2002, was considered but did not place the application in condition for allowance because

The amendment does not overcome the rejections of record.
Forfurther [sic] arguments see paper 8 mailed August 31, 2002.

The above fails to comply with MPEP 707.07(f)¹ and the Examiner's arguments from August 31, 2002, cannot possibly serve as a response to Applicants' arguments filed November 8, 2002.

¹ "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

As a result of not entering Applicants' Reply and Rule 132 Affidavit filed January 10, 2003, the Examiner did not reconcile his position regarding the on-sale/public-use rejection with the conclusions of his supervisor (Examiner Gregory L. Mills) and SPRE Christine Tierney, who held that on-sale/public-use rejections are governed by the decision in *Field v. Knowles; Field and Stover v. Same*, 86 USPQ 373 (CCPA 1950), and not the cases cited by the Examiner in the present Office Action. Applicants ask Examiner Zervigon to consult with Examiner Mills and SPRE Christine Tierney regarding this issue.

The Examiner continues to use the term "capability" in alleging what Dietrich teaches, though Applicants cannot find any support for such teachings in Dietrich. Applicants ask that the Examiner point out where in Dietrich he finds support for such teachings.

In the "Response to Arguments" in the Office Action of July 31, 2002, the Examiner explained that he did not consider Applicants' claimed limitations regarding their electron beam because such limitations are merely an "intended use" and not a structural difference. However, the claims examined by the Examiner expressly required the physical presence of the electron beam. The mere fact that an electron beam is not a solid structure is simply not relevant to whether the electron beam is a required element of Applicants' claims. To further emphasize that the electron beam

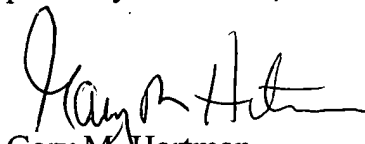
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is an element of Applicants' claimed invention, Applicants have amended independent claims 1 and 6 to clearly set forth the electron beam as a distinct element of the claimed apparatus.

Applicants respectfully request that their patent application be given favorable reconsideration. The Examiner is asked to call Applicants' undersigned representative if he has any questions with respect to the above, or any other matter now of record.

Respectfully submitted,

By


Gary M. Hartman
Reg. No. 33,898

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Hartman & Hartman, P.C.
Valparaiso, Indiana 46383
TEL.: (219) 462-4999
FAX: (219) 464-1166

Attachments: "Reply under 37 CFR §1.116" filed September 30, 2002.
"Supplemental Reply under 37 CFR §1.116" filed January 10, 2003.
"Declaration under 37 CFR §1.132" filed January 10, 2003.
Replacement Drawing Sheets (2).